



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q54532

Jorg SCHABERNACK, et al.

Appln. No.: 09/328,893

Group Art Unit: 2155

Confirmation No.: 7430

Examiner: Duong, Oanh L.

Filed: June 09, 1999

For: MANAGEMENT OF A NETWORK ELEMENT USING MANAGED OBJECTS IN A
DIGITAL COMMUNICATIONS NETWORK

#26
LDS
3-9-04

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

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Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated January 2, 2004. Entry of this
Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

**1. The Examiner ignores the meaning of the claimed term "managed object" as interpreted
by a person skilled in the art**

On pages 9-11 of Appellants' Appeal Brief, Appellants presented voluminous factual
evidence regarding the meaning of the claimed term "managed object" as it is interpreted by a
person skilled in the art.

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Despite Appellants' presentation of numerous specific facts pertaining to the meaning of this term, the Examiner continues to ignore the fact that the term "managed object" is a term of art that has a specific technical meaning to a person skilled in the art. Indeed, the Examiner acknowledges on page 7, second paragraph, of her Answer that she reads the claimed "managed object" merely as an "object". In other words, the Examiner impermissibly chooses to write the word "managed" out of Appellants' claims, thereby completely ignoring the meaning that the claimed term "managed object" is given by a person skilled in the art. Even though each of Appellants' claims expressly recite "managed objects", the Examiner, by her own admission, has in fact examined and rejected a different set of claims, not submitted by Appellants, that do not include the word "managed".

Pursuant to MPEP § 2173.05(a), cited on page 9 of the Appeal Brief, Appellants are not required to define the term "managed object" in their claims, if, as here, the term is a term of art and has a meaning that is apparent from the prior art (see Appellants' extensive discussion of the prior art materials on pages 9-11 of the Appeal Brief). Consequently, the Examiner's insistence on incorporating a definition of the term "managed object" in Appellants' claims is clearly improper. For the reasons presented in the Appeal Brief and, as apparent from the prosecution history, express recitation of the term "managed object" suffices to patentably distinguish the present invention over the applied art. The Examiner's requirement to distinguish the claims even further is beyond what is statutorily required.

Appellants have produced an extensive and specific factual record to demonstrate that the term "managed object" is a term of art. Appellants attach to this Reply Brief yet another prior art

reference evidencing the fact that the term “managed object” is a term of art that has a specific technical meaning to a person skilled in the art. The prior art reference in question is the article “Applying Network Management Standards to System Management; the case for the Common Agent”. The reference uses the term “managed object” throughout, and provides further evidence, entirely consistent with Appellants’ previous submissions, to support the Appellants’ contention that the term “managed object” itself suffices to distinguish the Appellants’ claims over the cited prior art.

The Examiner, on the other hand, has provided no factual rationale for redefining the term “managed object” as “object”. Based on the factual record provided, such a redefinition of the term “managed object” is not a reasonable interpretation, and, therefore, the Examiner has gone beyond the broadest reasonable interpretation of the term “managed object” in the grounds of rejection.

2. Contrary to the Examiner’s assertion, Mishra is not “similar” to Bennett and there is no motivation to combine the two references

On page 9 of the Examiner’s Answer, the Examiner asserts that Mishra discloses a management system that is “similar” to that of Bennett.

As noted on page 7 of the Appeal Brief, the Bennett reference is directed to an application program memory management system and relates to the management of memory

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resources in a computer.¹ In other words, Bennett addresses the problem that there is continuing competition among application programs for main memory capacity. A more detailed discussion of the Bennett reference can be found on pages 7 and 8 of Appellants' Appeal Brief. In particular, page 8 of the Appeal Brief discusses how code objects are swapped in and out of the main memory 102.

The Mishra reference teaches how in an SDH network traffic capacity can be booked in advance, on request of a user of the SDH network, by allocating a path through the network having the required capacity. Pages 16-18 of the Appeal Brief discuss the Mishra reference in more detail.

In other words, the Bennett reference is directed to a system and method that has nothing to do with the system and method disclosed in Mishra. The former is an application program memory management system and relates to the management of memory resources in a computer by swapping code objects in and out of the main memory 102; the latter is directed to an SDH network and addresses how traffic capacity can be booked in advance, on request of the user of the SDH network. These two technical concepts are entirely different and unrelated.

Therefore, the Examiner's statement that "Mishra discloses a management system, similar to that of Bennett" is clearly erroneous. As a consequence, the Examiner has failed to demonstrate why a person skilled in the art of application program memory management (as disclosed in Bennett) would have been motivated to even refer to the Mishra reference, which

¹ See Bennett reference, col. 1, ln. 1-7

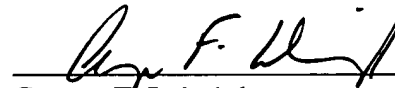
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addresses a completely unrelated problem (namely advanced booking of a path through an SDH network), let alone to combine the two references so as to arrive at Appellants' claimed invention.

CONCLUSION

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,


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